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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,165	06/15/2001	Joseph A. Manico	82117F-P	9385

7590

11/10/2005

Milton S. Sales
Patent Legal Staff
Eastman Kodak Company
343 State Street
Rochester, NY 14650-2201

EXAMINER

DIVINE, LUCAS

ART UNIT

PAPER NUMBER

2624

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/882,165

Applicant(s)

MANICO ET AL.

Examiner

Lucas Divine

Art Unit

2624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 26 October 2005. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, first paragraph, rejections of claims 1-4 and 7-18.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-4 and 7-20.

Claim(s) withdrawn from consideration: _____

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see Response to Arguments attached hereto.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____


KING Y. POON
PRIMARY EXAMINER

Response to Arguments

1. Applicant's arguments filed 10/7/05 have been fully considered but they are not persuasive.
2. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Kinjo teaches the differentiation between background and subject and is the base reference. Thus, the other references need not teach this limitation and are not relied upon to do so. Their features add benefit to the system of Kinjo and the rejection is based on the combination of references.

3. With respect to applicant's arguments in the 'Secondly...' paragraph of page 7.

In reply, Examiner agrees that Kinjo fails to teach the cutting of the image product as recited in the rejection.

4. With respect to applicant's arguments in the 'Miyazaki...' paragraph of pages 7-8.

In reply, Miyazaki teaches an image input, processing, and output system that can be used at photofinishing labs such as in Kinjo. The system of Miyazaki includes printing an inputted image (by printer controller and thermal head as shown in Fig. 12) and producing a cut image product from said sheet of media (by cutter controller 76 and cutter shown in Fig. 12; col. 1 lines 63-65).

It would have been obvious to one of ordinary skill in the art to add the printing and cutting device of Miyazaki in the photofinishing lab of Kinjo. The motivation for doing so would have been to provide the user with many more options for output of images. The cutting pattern

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as cut in Miyazaki is selected by the user [col. 2 line 5] and can be cut in any arbitrary pattern [col. 14 lines 65-67] which makes it beneficial to print and cut the selected and extracted patterns of Kinjo. Further, the inventions of Miyazaki and Kinjo would be combinable because they are both developed by the same assignee [meaning there ability to be integrated with each other is implied] and they share some of the same photo editing and printing tasks and options [see Kinjo Fig. 33 and Miyazaki Fig. 22].

Thus, Miyazaki clearly teaches and it relied upon for the teachings of a person having the desire to have a cut out, being able to select the cut out, and thus having a machine that will perform the cut out. This is clearly a nice feature of image production for users/customers that Kinjo would benefit from.

5. With respect to applicant's remarks on page 8 in the 'Matsumura...' paragraph.

The combination of Kinjo and Miyazaki teach cutting an image product based on position information (col. 11 line 37 of Miyazaki).

Neither Kinjo nor Miyazaki teach that the position information is obtained (located in) from the digital image data itself.

Matsumura teaches selecting an image subject and generating position information for the subject (Figs. 2 – 11) and that the structure of the digital image data after generating position information includes position information (Fig. 8C and its description), thus teaching that position information can be obtained (located in) from the digital image data itself.

It would have been obvious to one of ordinary skill in the art to include position data in the digital image itself instead of storing a table with the position data. The motivation for doing so would have been to speed up processing by removing the table access steps, to only send one

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group of information for printing (position and data) instead of separately, to save memory by not having to store a table, to allow the user the ability to send the image data to another lab or printing center and still have the position data be available with the data, to produce a less complicated system with less steps and groups of data, and other motivations for combining two pieces of digital information into one file.

Thus, Matsumra is not relied upon for the teachings of differentiating between background and subject or cutting as discussed above in item 1, and thus applicant cannot so prove unobviousness by this argument.